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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/221,539	12/28/98	CHENG	W 1010-1 <sup>mk</sup>

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EXAMINER

FREISCH, N

ART UNIT

PAPER NUMBER

1764

16

DATE MAILED: 05/22/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

**Office Action Summary**

Application No.

09/221,539

Applicant(s)

CHENG ET AL.

Examiner

Nadine Preisch

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 13-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

**Attachment(s)**

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

Applicants' arguments regarding the restriction requirement are untimely at this point because the restriction was made final in the office action mailed 10-25-00. Any further arguments are required to be submitted in the form of a petition. However, in an effort to address some of applicants' arguments, the following response is provided.

Applicants arguments asserting that the examiner is required to support agency action by substantial evidence of record in the proceedings are not persuasive for the removal the restriction. It is maintained that the examiner has made a proper restriction because an alternative use for the claimed product is provided and undue burden was shown as evidenced by a different classification for each invention.

Furthermore, applicants are reminded that evidence in the form of a reference is not required to support a proposed alternate use. The MPEP specifically states "The burden is on the examiner to provide an example, but the example need not be documented." (MPEP 806.05 (h)). In this instance, an example of an alternate use has been provided and the applicants have not provided a reason why the alternate use as suggested by the examiner can not be accomplished.

The MPEP also states that if applicant provides a convincing argument that the alternative use suggested by the examiner can not be accomplished, the burden is on the examiner to support a viable alternative. In this case, applicants have not provided a convincing argument explaining why the proposed alternate use can not be accomplished. However, in order to solidify the restriction, it is proposed that the claimed composition can be used in a

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materially different process such as the alkylation of isoparaffins with olefins. See Huang (5,705,729).

***Withdrawal of Claim Rejections Under 35 U.S.C. § 102(b)***

Applicants' amendment filed 3-7-01 is sufficient to overcome the 102 (b) rejection of claims 1-3, 5, 6 and 8.

***Withdrawal of Claim Rejections Under 35 U.S.C. § 103***

Applicants' argument stating that stable Y is not the same as USY is sufficient to overcome the rejection of claim 7 over Beck et al.(4,588,702) in view of Tan-no et al.(5,646,082) and Kugler (4,944,864).

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-12 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicants' "non-lanthanide metal" limitation in claims 1 and 9 is considered to be new matter because the specification does not provide any "recitation" of excluding such a component. An example that does not include such a limitation is not proper support for the conclusion that such lanthanide components are excluded from the entire disclosure.

***Claim Rejections - 35 U.S.C. § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-6 and 8 are rejected under 35 U.S.C. 103(a) as obvious over Beck et al.(4,588,702) in view of Kugler (4,944,864).

The reference of Beck et al.(4,588,702) discloses a process of cracking a hydrocarbon feed containing a sulfur containing compound in the presence of a catalyst. See column 14, lines 13-14 and column 9, lines 29-31. The process produces a high gasoline product. See column 11, line 1. The catalyst includes a USY component containing lanthanum and/or cerium. See column 15, line 61 and column 18, lines 41-42. The amount of rare earth oxides based on the total weight of the catalyst is 0.5 to 2%. See column 18, lines 41-51. The zeolite component may optionally be combined with a matrix material. See column 19, lines 64-66. An acceptable unit cell size ranges from 23.3-24.7 angstroms. See column 16, lines 46-49. The reference further teaches that the catalyst is separated, stripped, regenerated in the presence of oxygen and recycled back to the reaction zone. See column 27, line 51, column 28, line 23, column 29, lines 63-64 and column 30, lines 23-30.

The reference of Beck et al.(4,588,702) succeeds at disclosing a cracking process which results in the production of a gasoline with steps and catalyst components corresponding to those claimed by applicants.

Several differences are noted between the reference of Beck et al.(4,588,702) and applicants' claimed invention. Beck et al.(4,588,702) does not disclose the use of catalyst containing a non-lanthanide component such as vanadium. In addition, Beck et al.(4,588,702) is silent about sulfur reduction during cracking.

The reference of Kugler (4,944,864) is cited to show that it is known in the art that vanadium contaminants in a hydrocarbon feed which remain on a catalyst during regeneration are oxidized and that the oxidized vanadium compounds become mobile and react with the zeolite components of the catalyst. As a result, the regenerated catalyst contains vanadium. See column 4, lines 13-27.

The reference of Kugler succeeds in disclosing the concept that regenerated catalysts which are recycled in processes involving the treatment of vanadium containing feeds contain a non-lanthanide component in the form of vanadium resulting from contamination during the regeneration process.

Since the reference of Beck et al.(4,588,702) discloses a vanadium containing feed and a catalyst regeneration, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize a vanadium containing catalyst because the reference of Kugler teaches that it is known in the art that regenerated catalysts recycled for further cracking contain vanadium components. Applicants have not shown anything unexpected with respect to the use of a catalyst containing a vanadium component.

It is noted that the reference does not refer to a reduction in the sulfur concentration of the feed. However, the reduction sulfur in the feed would naturally result from the use of a catalyst produced by the modified teachings of Beck et al.(4,588,702) because the modified teachings encompass a catalyst corresponding to that claimed by applicants which would accomplish the same result when subjected to cracking conditions

***Claim Rejections - 35 U.S.C. § 103***

Claims 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Beck et al.(4,588,702) in view of Kugler (4,944,864) as applied to claims 1-6 and 8 above, in further view of Cooper et al.(5,601,798).

-See teachings of Beck et al.(4,588,702) and Kugler (4,944,864) above.

Several differences are noted between the modified teachings of Beck et al.(4,588,702) and applicants' claimed invention. The reference does not disclose the specific unit cell size or SiO<sub>2</sub>/Al<sub>2</sub>O<sub>3</sub> ratio of the USY composition.

The reference of Cooper et al.(5,601,798) is cited to illustrate that USY typically has a unit cell ranging from 24.5 angstroms (2.45 nm) to 24.6 angstroms (2.46 nm) and a silica/alumina ratio ranging from 5-12. See column 4, lines 64-66.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to select the unit cell size and the SiO<sub>2</sub>/Al<sub>2</sub>O<sub>3</sub> ratio disclosed by the reference of Cooper et al.(5,601,798) for the USY catalyst used in the Beck et al. process because the reference of Cooper et al.(5,601,798) illustrates that such a unit cell size and a SiO<sub>2</sub>/Al<sub>2</sub>O<sub>3</sub> ratios are conventional in the art. Since the reference of Beck et al.(4,588,702) does not limit the parameters of the USY, it is considered to encompass conventional parameters which would accomplish the desired conversion. Applicants have not shown anything unexpected with respect to the claimed unit cell size or SiO<sub>2</sub>/Al<sub>2</sub>O<sub>3</sub> of the USY component.

***Claim Rejections - 35 U.S.C. § 103***

Claims 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beck et al.(4,588,702) in view of Kugler (4,944,864) as applied to claims 1-6 and 8 above, in view of Occelli (4,615,996).

-See teachings of Beck et al.(4,588,702) and Kugler (4,944,864) above.

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A difference is noted between the reference of Beck et al.(4,588,702) and applicants' claimed invention. The reference of Beck et al.(4,588,702) is silent with respect to the catalyst particle size.

The reference of Occelli (4,615,996) is cited for the general teaching that it is conventional in the art to use catalysts with particle sizes of less than 75 microns in FCC processes. See column 1, lines 25-30 and lines 35-40.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize a catalyst particle size of less than 75 microns in the Beck et al. process because the reference of Occelli (4,615,996) illustrates that such catalyst particle sizes are conventional in the art for hydrocarbon cracking. Applicants have not shown anything unexpected with respect to the size of the catalyst particles.

In addition, the particle size is not considered to be a patentable distinction over the applied art because changes in size are not invention of a rule. In re Rose, 105 USPQ 237 (CCPA 1955).

### ***Claim Rejections - 35 USC § 103***

Claims 1-3, 5, 6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Balko et al.(5,956,474) in view of Schorfheide (4,690,806).

The reference of Balko et al.(5,965,474) discloses a composition for use in catalytic cracking. See abstract, lines 1-2. The composition comprises a rare earth (cerium and/or manthanum) exchanged faujasite such as USY. See column 3, line 11 and column 4, lines 13-14 and 25-39. The feeds processed are conventional feeds such as gas oil or vaccuum gas oil. See column 4, lines 1-10. Contaminating metals such as vanadium and organic compounds are present. See column 2, lines 23-34. The reference discloses a gas oil feed containing sulfur. See



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column 21, lines 3-4 and 20. The reference also teaches that conventional FCC catalysts have particle diameters ranging from about 20-150 microns. See column 2, lines 5-10. Balko et al.(5,965,474) further teaches that the catalyst can be ion exchanged with additional metals such as Zn. See column 12, lines 24-36.

The reference of Balko et al.(5,965,474) succeeds at disclosing a cracking process involving the use of a catalyst with components corresponding to those claimed by applicants. The disclosure of rare earth and Zn exchanged compositions are considered to meet applicants' component (i) and (ii) limitations in claim 1.

Several differences are noted between the reference of Balko et al.(5,965,174) and applicants' claimed inventions. The reference of Balko et al.(5,965,174) is silent about sulfur in the form of organosulfur compounds and the sulfur reduction of the feed.

The reference of Schorfheide (4,690,806) illustrates that gas oil is known to contain organosulfur compounds in the form of thiophenes and benzothiophenes. See column 2, lines 17-22.

Since Balko et al.(5,965,174) involves the treatment of a gas oil, it would have been obvious to one of ordinary skill in the art at the time the invention was made to treat an organosulfur containing feed according to the cracking process of Balko et al.(5,965,174) because the reference of Schorfheide (4,690,806) illustrates that gas oils are known to contain organosulfur compounds. Furthermore, the modified teachings of Balko et al.(5,965,174) would naturally encompass sulfur reduction because the reference discloses the use of a catalyst with the same components claimed by applicants which would have the same catalytic properties.

***Claim Rejections - 35 USC § 103***

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Balko et al.(5,965,474) in view of Schorfheide (4,690,806) as applied to claim 1-3, 5, 6 and 8 above, and further in view of Cooper et al.(5,601,798).

A difference is noted between the modified teachings of Balko et al.(5,965,474) and applicants' claimed invention. The modified teachings of Balko et al.(5,965,474) are silent about the unit cell size and silica/alumina ratio of the USY component.

The reference of Cooper et al.(5,601,798) is cited to illustrate that USY typically has a unit cell ranging from 24.5 angstroms (2.45 nm) to 24.6 angstroms (2.46 nm) and a silica/alumina ratio ranging from 5-12. See column 4, lines 64-66.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to select the unit cell size and the  $\text{SiO}_2/\text{Al}_2\text{O}_3$  ratio disclosed by the reference of Cooper et al.(5,601,798) for the USY catalyst used in the Balko et al.(5,965,474) process because the reference of Cooper et al.(5,601,798) illustrates that such unit cell sizes and  $\text{SiO}_2/\text{Al}_2\text{O}_3$  ratios are conventional in the art. Since the reference of Beck et al.(4,588,702) does not limit the parameters of the USY, it is considered to encompass conventional parameters which would accomplish the desired conversion. Applicants have not shown anything unexpected with respect to the claimed unit cell size or  $\text{SiO}_2/\text{Al}_2\text{O}_3$  of the USY component.

***Claim Rejections - 35 USC § 103***

Claims 4 and 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Balko et al.(5,965,474) in view of Schorfheide (4,690,806) as applied to claims 1-3, 5, 6, and 8 above, and further in view of Kugler (4,944,864).

A difference is noted between the modified teachings of Balko et al.(5,965,474) and applicants' claimed invention. The modified teachings do not suggest a vanadium catalyst component or catalyst regeneration.

The reference of Kugler (4,944,864) is cited to show that it is known in the art that vanadium contaminants in a hydrocarbon feed which remain on a catalyst during regeneration are oxidized and that the oxidized vanadium compounds become mobile and react with the zeolite components of the catalyst. As a result, the regenerated catalyst contains vanadium. See column 4, lines 13-27.

The reference of Kugler succeeds in disclosing the concept that oxidative regeneration is conventional for FCC catalysts and that regenerated catalysts which are recycled in processes involving the treatment of vanadium containing feeds contain a non-lanthanide component in the form of vanadium resulting from contamination during the regeneration process.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to regenerate the catalyst of Balko et al.(5,965,474) because Kugler (4,944,864) illustrates that it is conventional in the art to oxidatively regenerate FCC catalysts.

Since the reference of Balko et al.(5,965,474) discloses a vanadium containing feed, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize a vanadium containing catalyst because the reference of Kugler teaches that it is known in

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the art that regenerated catalysts recycled for further cracking contain vanadium components.

Applicants have not shown anything unexpected with respect to the use of a catalyst containing a vanadium component.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-4 and 6-12 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2 and 4-12 of copending Application No. 09/221,540. Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications are drawn to a process of reducing sulfur in a catalytically cracked petroleum containing organosulfur compounds in the presence of a catalyst containing a first metal which is on the interior pore structure of a molecular sieve and a second metal component.

Several differences are noted between the present claims and the claims of copending Application No. 09/221,540. Present claim 1 includes a second metal component comprising at least one rare earth component whereas claim 1 of copending Application No. 09/221,540

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includes a second metal component comprising cerium. Present claim 6 includes a second metal amount of 1-10 weight percent whereas copending Application No. 09/221,540 includes a second metal amount of 0.5-10 weight percent.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to select cerium as the second metal component in claim 1 of the present application because cerium is metal which reads on applicants' rare earth component limitation. Applicants' include cerium as a further limitation in the present dependent claims. As a result, the cerium limitation in copending Application No. 09/221,540 appears to read on the subject matter claimed in the present application.

In addition, it would have been obvious to one of ordinary skill in the art at the time the invention was made to select any second metal amount overlapping the amount claimed in copending Application No. 09/221,540 because it has been held that in the case where claimed ranges overlap, a prima facie case of obviousness exists. In re Wertheim, 541 F.2d 257, 191 USPQ 90 (CCPA 1976).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Double Patenting***

Claims 1-4, 6, and 8-12 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6, 8 and 11-14 of copending Application No. 09/468,452. Although the conflicting claims are not identical, they

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are not patentably distinct from each other because both sets of claims are drawn to a method of reducing the sulfur content of a catalytically cracked petroleum fraction.

A difference is noted between the present claims and the claims of application No. 09/468,452. Applicants' claims define a rare earth metal component whereas the claims of Application No. 09/468,452 define a cerium component.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to select any rare earth metal in applicants' claims, including cerium, because the present claims do not exclude the use of any rare earth metal.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Double Patenting***

Claims 1-4, 8-10 and 12 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 4, 5, and 10-14 of copending Application No. 09/144,607 in view of Beck et al.(4,588,702).

Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are drawn to a process for reducing the sulfur content of a catalytically cracked petroleum feed fraction in the presence of a cracking catalyst and a product sulfur reduction catalyst.

A difference is noted between the present claims and the claims of Application No. 09/144,607. Claim 1 of Application No.09/144,607 does not include an additional rare earth component as defined in applicants' claim 1.

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The reference of Beck et al.(4,588,702) teaches that rare earth components are known promoters in catalytic cracking processes. See column 9, lines 30-35 and column 10, lines 49-55.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include an additional rare earth component in the claims of 09/144,607 because Beck et al.(4,588,702) illustrates that rare earths are known promoters in catalytic cracking.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Applicants have provided evidence in this file showing that the invention was owned by, or subject to an obligation of assignment to, the same entity as 09/144,607 at the time this invention was made. Accordingly, 09/144,607 is disqualified as prior art through 35 U.S.C. 102(f) or (g) in any rejection under 35 U.S.C. 103(a) in this application. However, this applied art additionally qualifies as prior art under another subsection of 35 U.S.C. 102 and accordingly is not disqualified as prior art under 35 U.S.C. 103(a).

Applicants may overcome the applied art either by a showing under 37 CFR 1.132 that the invention disclosed therein was derived from the invention of this application, and is therefore, not the invention "by another," or by antedating the applied art under 37 CFR 1.131.

### ***Response to Arguments***

Applicants' arguments filed 3-7-01 have been fully considered but they are not persuasive.

Applicants' arguments asserting that Beck et al.(4,588,702) does not suggest vanadium entering the inner pore structure of the pore are addressed in the modified rejection above. It is maintained that the secondary reference of Kugler (4,944,864) suggests that vanadium in the feed migrates to the zeolite component and remains on the catalyst after regeneration. The presence of oxidized vanadium meets applicants' non-lanthanide component limitation.

In addition, it is conceded that vanadium acts as a poison in the disclosed Beck et al.(4,588,702) catalyst. However, the secondary reference of Kugler (4,944,864) illustrates that small amounts of vanadium are known to be present on regenerated catalysts and that such catalysts still maintain some functionality. Furthermore, Kugler's referral to accumulation in high zeolite areas is considered to encompass any portion of the zeolite, including the pores, because the reference does not restrict the accumulation to any specific portion of the zeolite. Kugler's disclosure of the migration of the vanadium through the areas of high zeolite concentration is considered to include the pores. The position is taken that in order for the vanadium to migrate, it must pass through the pores. Furthermore, since the reference does not limit what portion of the zeolite the vanadium migrates to, it is considered to encompass any accessible part of the zeolite, including the pores.

Though such contaminants may not be desired, the catalyst is not thrown away after one use. Regenerated catalysts function even though they contain small portions of undesirable contaminants. Applicants' claiming of a less desirable embodiment of the prior art, such as an embodiment including vanadium, does not distinguish the invention over the applied art.

In addition, applicants' argument that the references attach vanadium to the catalyst during use whereas the claimed catalyst incorporates vanadium during the process of making do



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not distinguish the claimed invention because such method of making limitations are not contained in the claims. Furthermore, applicants' have not shown a difference between a composition with vanadium is added during preparation and a composition with vanadium added during use.

Applicants' arguments maintaining that the double patenting rejection over Application No. 09/221,540 is in error because mixtures of rare earth catalysts and catalysts containing cerium have different activities are not persuasive. In response, it is maintained that that applicants' claim 1 only requires "at least one rare earth". The claims of 09/221,540 define "cerium" which reads on applicants' limitation of "at least one rare earth".

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nadine Preisch whose telephone number is 703-305-2667. The examiner can normally be reached on Monday through Thursday from 7:30 am to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marian Knode can be reached on 703-308-4311. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3599 for regular communications and 703-305-5408 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

N.P.  
May 18, 2001



**NADINE PREISCH**  
**ART UNIT 1764**

